

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-3 and 5-20 are pending in this application. Claim 4 is canceled without prejudice or disclaimer, Claims 1 and 18 are amended, and new Claim 20 is added by the present amendment. As amended Claims 1 and 18 and new Claim 20 are supported by the original claims, no new matter is added.

In the outstanding Official Action, Claims 1-19 were rejected under 35 U.S.C. §102(b) as anticipated by Watanabe (Japanese Patent Publication No. 6-103992).

With regard to the rejection of Claim 1 under 35 U.S.C. §102(b) as anticipated by Watanabe, that rejection is respectfully traversed.

Amended Claim 1 recites “*an electric voltage application means* provided either between the internal electrode and the fuel electrode or between the internal electrode and the oxidant electrode.”

In contrast, Watanabe does not teach or suggest *any* means for applying an electric voltage to any portion of the described cell, much less “between the internal electrode and the fuel electrode or between the internal electrode and the oxidant electrode” as recited in Claim 1. In fact, the outstanding Office Action does not cite any portion of the device described by Watanabe as “an electric voltage application means.”¹ Accordingly, it is respectfully submitted that Watanabe does not teach or suggest “an electric voltage application means” as recited in Claim 1. As Watanabe does not teach each and every element of amended Claim 1, Claim 1 (and Claims 2, 3, 5-17 and 20 dependent therefrom) is not anticipated by Watanabe and is patentable thereover.

¹See the outstanding Office Action at page 2, lines 15-22.

With respect to Claim 6, which recites that the electric voltage application means is a potentiostat, the outstanding Office Action concedes that:

Tanaka et al., do not teach potentiostat between internal electrode and fuel or oxidant electrode.

However, the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made because although it does not specifically describe the location of the potentiostat, sect. 0015 recites “electrical potential difference was measured ...” which could be measured via a potentiostat.²

Thus, the outstanding Office Action concedes that Watanabe does not teach all of the elements of Claim 6 either. The assertion that “the invention as a whole would have been obvious” is clearly contrary to well settled case law that holds to establish *prima facie* obviousness of a claimed invention, ***all the claim limitations must be taught or suggested by the prior art***. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Emphasis added.) See also MPEP §2143.03. As the outstanding Office Action concedes that Watanabe does not teach or suggest “a potentiostat” as recited in Claim 6, a *prima facie* case of obviousness of Claim 6 has not been established by the outstanding Office Action.

Further, the potentiostat recited in Claim 6 is an electric voltage ***application*** means, not a voltage ***measurement*** device. Thus, the portion of Watanabe cited in the outstanding Office Action with respect to a potentiostat is in fact irrelevant to the pending claims.

Consequently, Claim 6 further defines over Watanabe.

New Claim 20 is supported at least by the original claims and is patentable as it depends from allowable Claim 1. Moreover, Claim 20 recites subject matter that further defines over Watanabe.

New Claim 20 recites “the electric voltage application means is electrically connected to the internal electrode.”

²Outstanding Office Action page 2, line 23 to page 3, line 4.

As noted above, there is no teaching or suggestion in Watanabe for “an electric voltage application means.” Further, Watanabe describes that a catalyst layer 7 is provided inside an ion exchange membrane. However, an electric voltage is **not** applied to the catalyst layer 7. As clearly described in Watanabe, a “catalytic layer 7 electrically insulated from a cathode 2 and anode 4”³ and “said catalyst bed 7 is insulated electrically.”⁴ Paragraph 17 of Watanabe only describes that the catalyst metal is electrically conductively connected to a charge collector, not an electric voltage application means. Thus, Watanabe also does not teach or suggest “the electric voltage application means is electrically connected to the internal electrode” as recited in new Claim 20. Accordingly, new Claim 20 further patentably defines over Watanabe.

Amended independent Claim 18 recites “controlling a movement of the fuel or the oxidant in the electrolyte by applying an electric voltage either between the internal electrode and the fuel electrode or between the internal electrode and the oxidant electrode.” As noted above, Watanabe does not describe **applying** a voltage between an internal electrode and any other electrode. Thus Watanabe does not teach or suggest “controlling a movement of the fuel or the oxidant” as recited in Claim 18. Thus, Claim 18 (and Claim 19 dependent therefrom) is not anticipated by Watanabe and is patentable thereover.

³Watanabe, Abstract.

⁴Watanabe, paragraph 11.

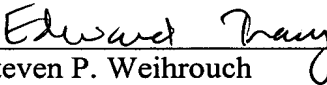
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Reply to Office Action of December 1, 2005

Accordingly, in view of the present amendment, no further issues are believed to be outstanding and the present application is believed to be in condition for formal allowance.

An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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